



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,455	04/08/2004	Myles S. Douglas	ENDOLOG.054A	7278

20995 7590 04/16/2008
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

TYSON, MELANIE RUANO

ART UNIT	PAPER NUMBER
----------	--------------

3773

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

04/16/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No. 10/820,455	Applicant(s) DOUGLAS ET AL.	
	Examiner Melanie Tyson	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 31-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 January 2008 has been entered. Corrections made to the claims have been accepted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaolian et al. (6,197,049). Shaolian discloses a stent graft comprising all the configurations as claimed (see columns 6-21). Shaolian further discloses the porosity characteristics of the sheath (44) may vary and portions may be nonporous. Therefore, Shaolian discloses the sheath is configured to inhibit sufficient cellular ingrowth through the wall as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3773

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaolian et al. (6,197,049). Shaolian discloses a stent graft comprising all the configurations as claimed (see columns 6-21). Shaolian further discloses the porosity characteristics of the sheath (44) may be either homogeneous throughout the axial length of the prosthesis or may vary according to the axial position along the prosthesis (for example, see column 6, lines 49-52). Shaolian teaches examples in which the sheath (44) may be nonporous or provided with pores of relatively low porosity in areas where anchoring is less of an issue, and thus does not require endothelial growth (for example, see column 6, lines 61-67). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the sheath to prevent cellular growth through portions of the sheath that contacts the vessel wall in applications that do not require sufficient anchoring or in applications where

anchoring is undesirable. Doing so would prevent tissue damage of the surrounding healthy vessel wall and thus prevent occlusion of the healthy vessel.

Response to Arguments

Applicant's arguments filed 07 January 2008 have been fully considered but they are not persuasive. Applicant argues primarily that the applied prior art fails to teach or suggest all of the claim language of amended claims 1, 18, and 31-34, the prior art teaches away from the claimed invention, and the prior art fails to provide motivation. Examiner respectfully disagrees.

Applicant argues that Shaolian fails to teach or suggest all of the claim language, specifically a sheath configured to inhibit sufficient cellular ingrowth through the wall of the sheath, or prevents tissue ingrowth through portions of the sheath that contact the vessel wall. However, Shaolian discloses the porosity characteristics of the sheath (44) may vary and portions may be nonporous in areas where anchoring is less of an issue, and thus does not require endothelial growth (for example, see column 6, lines 61-67). Therefore, Shaolian discloses the sheath is configured to inhibit sufficient cellular ingrowth through the wall as claimed in claims 1 and 18.

Applicant further argues that Shaolian teaches away from preventing tissue ingrowth through portions of the sheath that contact the vessel wall, since Shaolian discloses a "**preferred embodiment** of the invention" in which the portions of the sheath that contact the vessel wall "**preferably** encourage endothelial growth." However, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Sushi*, 440 F.2d

Art Unit: 3773

442, 169 USPQ 423 (CCPA 1971). Since Shaolian teaches the sheath (44) may be nonporous or provided with pores of relatively low porosity in areas where anchoring is less of an issue, and thus does not require endothelial growth (for example, see column 6, lines 61-67), it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the sheath to prevent cellular growth through portions of the sheath that contacts the vessel wall in applications that do not require sufficient anchoring or in applications where anchoring is undesirable (see new rejection above for details). With respect to the applicant's argument that one would not be motivated to modify Shaolian's device as claimed, providing a sheath configured to prevent tissue ingrowth on the portions of the sheath that contact the vessel wall would prevent tissue damage of the surrounding healthy vessel wall and thus prevent occlusion of the healthy vessel (see new rejection above for details).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3773

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
March 26, 2008

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773